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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,919	08/06/2003	Claudius Zeiler	5858-00800	8849
7590 Conley Rose, P.C. P.O. Box 684908 Austin, TX 78768-4908			EXAMINER SWIGER III, JAMES L	
			ART UNIT 3775	PAPER NUMBER
			MAIL DATE 12/08/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/635,919

**Applicant(s)**

ZEILER ET AL.

**Examiner**

JAMES L. SWIGER III

**Art Unit**

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-19, 21, 22 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) 17-19, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/19/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Finality***

In view of the appeal brief filed on 12/6/2007, PROSECUTION IS HEREBY REOPENED. Rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

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### ***Claim Objections***

Claim 29 is objected to because of the following informalities: In line 26, applicant has already acknowledged that "hood" should be --hook--, but is reminded to make this change in a subsequent claim submission. Appropriate correction is required.

For claim 29, line 2 in the preamble, it is also suggested to add the word "bone" after "upper arm" to read --proximal upper arm bone-- to make the claim terminology

consistent throughout the body of the claim and to establish the intended environment of the stabilizing device.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

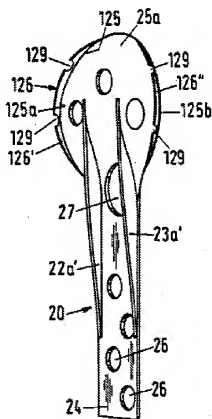
Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzberg (US Patent 4,988,350) in view of Carter (US Patent 5,006,120).

Herzberg discloses an implant plate (Fig. 17, 20) for stabilizing a fracture having a plate member (20) with holes (26) for bone screws (see Col. 7, lines 25-35) located on both the head and shaft portion, at least one receiving member (129) for receiving flexible cerclage wires (see Col. 9, lines 55-60) and wherein these receiving members face away from bone (as shown in the side profile in Fig. 18) and is considered hook-like and also is substantially circular. The notches allow for passage and tightening of suture material after the plate has been secured. Fig. 17 appears to be a one-piece plate and the plate further has a head end (25a) as well as a shaft end (24) that is narrower than the head end. The head and shaft portions are designed to be placed against the bone and further capable of being placed against upper arm head bone and also proximal upper arm bone. It is noted that Herzberg also mentioned that the implant plate may be made from any of a number of suitable materials. With regards to the one-piece plate being cut or punched from a metallic strip material, this is considered a

product by process. "Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on the method of its production. If the product in the product-by-process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

A copy of Herzberg is shown below.

Fig.17



Herzberg discloses the claimed invention except for specifically a suitable material that is implant steel or titanium, the plate being bent, or the plate having a uniform thickness that ranges from 0.5mm to 6.5mm or from 0.8-3.5mm. Carter shows a fracture fixation plate that is bent (see 22, and also Col. 2, lines 50-60). Besides having a plate shape based on it's suitability, Carter discloses that this shape modification allows it to better fit the target bone area. Additionally, Carter discloses that a plate may also be between 2-3mm and that the plate may be made of any known biocompatible material such as titanium or stainless steel. It would have been obvious to one having ordinary skill in the art to construct the device of Herzberg having specifically a suitable material that is implant steel or titanium, the plate being bent, or the plate having a uniform thickness that ranges from 0.5mm to 6.5mm or from 0.8-3.5mm in view of Carter so that the plate can have optimum fit in the target area and also have proper biocompatibility.

### ***Response to Arguments***

Applicant's arguments with respect to claims 29-31 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is

(571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/  
Examiner, Art Unit 3775

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733